

REMARKS

Claims 1-16 and 18-22 are pending in this application after this Amendment. Claim 17 has been canceled without prejudice or disclaimer to the subject matter contained therein. New claims 20-22 have been added. In light of the amendments and remarks made herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner requested formal drawings. The Examiner further rejected claims 1, 2, 4, 7-9, 13, and 16-19 under 35 U.S.C. § 103(a) as being unpatentable over *Dwinell et al.* (USP 6,267,293) in view of *Robertson et al.* (USP 6,446,868); rejected claims 3-6 under 35 U.S.C. § 103(a) as being unpatentable over *Dwinell et al.* and *Robertson et al.* and further in view of *Klancnik et al.* (USP 5,550,365); and rejected claims 14 and 15 under 35 U.S.C. § 103(a) as being unpatentable over *Dwinell et al.* and *Robertson et al.* and further in view of *Sizer, II et al.* (USP 6,036,086). Applicants respectfully traverse these rejections.

Applicants wish to thank the Examiner for allowing claim 10 and for further indicating that claims 9, 11, and 12 contain allowable subject matter.

Interview

Applicants wish to thank the Examiner for the interview conducted on March 25, 2004. During the interview, Applicants provided the Examiner with a description of the claimed invention,

and the parties further discussed the distinction between the claimed invention and the cited reference. It is respectfully submitted that the remarks contained herein are made further to the discussions had during the interview.

Drawings

In response to the Examiner's request for formal drawings, Applicants note formal drawings were filed together with the submission of the instant application. This has been confirmed with the Examiner during a telephone conference on April 9, 2004. It is respectfully requested that this request for formal drawings be withdrawn.

Claim Rejections - 35 U.S.C. § 103 - *Dwinell et al./Robertson et al.*

In order to sustain a rejection under 35 U.S.C. § 103(a), it is respectfully submitted that the Examiner must meet his burden to establish a *prima facie* case. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In support of the Examiner's rejection of claim 1, the Examiner asserts that *Dwinell et al.* teaches detecting edges of the barcode in each image of the subset of images and determining, from the detected edges of each image of the subset of images, possible displacements of the detected edges in relation to the detected edges of at least one other image of the subset of images, citing to col. 2, line 49 - col. 8, line 3 and the Abstract. Applicants respectfully disagree with the Examiner's characterization of this reference.

The disclosure of *Dwinell et al.* is directed to a barcode scanning system and method. The method provides for successively scanning the barcode and providing, for each scan, a plurality of data elements forming a scan fragment for at least a portion of the barcode. Each fragment containing a portion of a reference key is identified and the system detects when there has been a match between a reference key and the identified key fragments. Once a complete key has been constructed from the key fragments, a displacement between the key fragments which constructed the complete key is calculated and the data fragments of the barcode are aligned by placing each successive data fragment in alignment with the previous data fragment offset by the amount of the displacement. (Abstract).

However, the present invention as set forth in claim 1 recites, *inter alia*, a method for recording a bar code comprising

determining, from the detected edges of each image of the subset of images, possible displacements of the detected edges in relation to the detected edges of at least one other image of the subset of images. There is no teaching or suggestion in *Dwinell et al.* that is directed to this claim element. *Dwinell et al.* merely teaches calculating a displacement between the key fragments which construct the complete key. There is no teaching or suggestion in *Dwinell et al.* that is directed to determining, from the detected edges of each image of the subset of images, possible displacements of the detected edges in relation to the detected edges of at least one other image of the subset of images.

Robertson et al. fails to cure the deficiencies of the teachings of *Dwinell et al.*, as the rejection asserted by the Examiner fails to establish *prima facie* obviousness. *Robertson et al.* fails to teach or suggest this claim element. As such, *Dwinell et al.* and *Robertson et al.* fail to teach or suggest determining, from the detected edges of each image of the subset of images, possible displacements of the detected edges in relation to the detected edges of at least one other image of the subset of images, assuming these references are combinable, which Applicants do not admit. It is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 2-9 and 22 are allowable for the reasons set forth above with regard to claim 1 at

least based upon their dependency on claim 1. It is further respectfully submitted that claims 13, 16, and 17 contain elements similar to those discussed above with regard to claim 1 and, thus, claims 13, 16, and 17, together with claims dependent thereon, are not obvious over the references as cited by the Examiner.

Conclusion


Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.


Applicants respectfully petition for a one (1) month extension of time pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). A check in the amount of \$110.00 in payment of the extension of time fee is attached.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  #39,491
for Michael K. Mutter, #29,680


MKM/CMV/jdm
4830-0107P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

(Rev. 02/12/2004)